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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,163	07/10/2003	Matthew Stewart Gebhard	99-029A	2716
21898	7590	10/01/2004	EXAMINER	
ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			REDDICK, MARIE L	
		ART UNIT	PAPER NUMBER	
		1713		

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	<i>SL</i>
	10/617,163	GEBHARD ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07/10/03; 10/20/03.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/20/03.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to a composition, classified in class 524, subclass 238.
 - II. Claims 6-10, drawn to a method of coating, classified in class 427, subclass 385.5.
2. The inventions are distinct, each from the other because:
3. Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (claims 1-5) can be used in an entirely different process such as in a process in which the composition is extruded into a free-standing sheet.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Ms. Marcella M. Bodner, on September 28, 2004, a provisional election was made with traverse to prosecute the invention of Group II, claims 6-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an

inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "emulsion polymer" per claims 6 and 9 constitutes indefinite subject matter as per it not being readily ascertainable as to whether applicant intends a polymer having been made via aqueous emulsion polymerization techniques are the isolated product therefrom.

B) The recited "-20 C to 100 C" per claims 6 & 9 constitute indefinite subject matter as per the "degree" symbol being absent in the temperature range.

C) The recited "water solubility less than 8 %" per claim 6 and "water solubility of 8 % or more" per claim 9 constitutes indefinite subject matter as per the entity that said contents are being based on is not readily ascertainable.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 6-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,509,064. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the method for producing a coating on a friable surface including (1) applying to said friable surface a layer of an aqueous coating composition and (2) drying said coating composition per the claims of U.S. Patent'064 overlaps in scope with the method for improving the adhesion of a dried aqueous coating composition to a friable surface including (a) forming an aqueous coating composition, (b) applying said aqueous coating composition to a surface and (c) drying, or allowing to dry, said aqueous coating composition per the instantly claimed invention. As to the recited "improvement in adhesion", such is considered to be a necessary result from the method of producing a coating on a friable surface per the claims of U. S.'064.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gebhard et al (U.S. 5,623,085).

Gebhard et al disclose and exemplify waterborne coating composition and methods of coating substrates such as wood, painted wood etc. with said waterborne coating composition and drying the composition wherein said waterborne coating composition is defined as containing an emulsion polymerized addition polymer, the addition

polymer derived from at least one ethylenically unsaturated monomer which includes (meth)acrylic ester monomers such as methyl acrylate, ethyl acrylate(WS = 2.88), methyl methacrylate, 2-ethylhexyl acrylate(WS = 0.0172), vinyl acetate (WS = 9.65), styrene (WS = 0.0672), etc. and 0.1 to 20 wt.% of ethylenically unsaturated acid monomer(s) such as (meth) acrylic acid, etc., a reactive modifier which includes a polyethoxylated amine such as Ethomeen 18/25 and other conventional additives such as emulsifiers, wetting agents, pigments, fillers, etc. wherein the emulsion polymerized addition polymer is governed by a glass transition temperature(Tg) of -30 to 100° C and a particle size of 30 nanometers to 500 nanometers. See, e.g., the Abstract, cols. 1-5 and the Runs, especially Run 1 of Gebhard et al. Gebhard et al therefore anticipate the instantly claimed invention with the understanding that the method of coating per Gebhard et al overlaps in scope with the instantly claimed method of coating. Although silent with respect to the acid no., it is reasonably presumed that the acid no., as claimed, may be met by the emulsion polymerized addition polymer of Gebbhard et al since the emulsion polymerized addition polymer of Gebhard et al is essentially the same as and made in essentially the same manner as the claimed aqueous emulsion polymer and in the absence of the United States Patent and Trademark Office to have at its disposal the tools nor facilities to make determinations of this sort.

As to the claimed properties such as "improved adhesion", it is well settled that when a claimed product reasonably appears to be substantially the same as the product disclosed in the prior art, the burden of proof is on applicant to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product (*In re Spada*, 15 USPQ 2d 1655 (AFC 1990)).

It has been held that where applicants claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433(CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated by the disclosure of Gebhard et al, it would have been obvious to the skilled artisan to extrapolate, from Gebhard et al, the precisely defined method of coating, as claimed, as per such having been within the purview of the general disclosure of Gebhard et al and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 9 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebhard et al (U.S. 5,623,085).

Gebhard et al disclose and exemplify waterborne coating composition and methods of coating substrates such as wood, painted wood etc. with said waterborne coating composition and drying the composition wherein said waterborne coating composition is defined as containing an emulsion polymerized addition polymer, the addition polymer derived from at least one ethylenically unsaturated monomer which includes (meth)acrylic ester monomers such as methyl acrylate, ethyl acrylate(WS = 2.88), methyl methacrylate, 2-ethylhexyl acrylate(WS = 0.0172), vinyl acetate (WS = 9.65), styrene (WS = 0.0672), etc. and 0.1 to 20 wt.% of ethylenically unsaturated acid monomer(s) such as (meth) acrylic acid, etc., a reactive modifier which includes a polyethoxylated amine such as Ethomeen 18/25 and other conventional additives such as emulsifiers, wetting agents, pigments, fillers, etc. wherein the emulsion polymerized addition polymer is governed by a glass transition temperature(Tg) of -30 to 100° C and a particle size of 30 nanometers to 500 nanometers. See, e.g., the Abstract, cols. 1-5 and the Runs, especially Run 1 of Gebhard et al.

It would have been obvious to the skilled artisan to extrapolate, from Gebhard et al, the precisely defined aqueous coating composition-governed method of applying said coating composition to a surface, as claimed, as per such having been within the purview of the general disclosure of Gebhard et al and with a reasonable expectation of success, absent a showing of unexpected results commensurate in scope with the claims.

As to the "adhesion improvement" property, it is tenable that this property may be met by Gebhard et al since the aqueous coating composition, as modified supra, and method of application is structurally similar to the claimed aqueous coating composition and method of application. In any event, a *prima facie* case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. *In re Dillon* 16 USPQ2nd 1897 (CAFC, en banc, 1990), which overrules *In re Dillon* 13 USPQ 2nd 1337 and *In re Wright* 6 USPQ 2nd 1959.

The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

19. The additional prior art, listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *Jmr*
09/29/04